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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,155	01/13/2005	Ilkka Westman	60282.00232	9041
32294 7590 08/25/2009 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212			EXAMINER HO, DUC CHI	
			ART UNIT 2419	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/521,155

**Applicant(s)**

WESTMAN ET AL.

**Examiner**

DUC C. HO

**Art Unit**

2419

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-45, 48-61 and 80-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-45, 48-61, 80-85, 87 and 88 is/are rejected.
- 7) ☒ Claim(s) 86 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 42, 45, 48, 56-58, and 60-61 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art of the instant application, pages 1-4, hereinafter referred to as the APA.

Regarding claim 42, the APA discloses a method for routing a E.164 message from a user in an originating network to a subscriber in the terminating network via a foreign network, wherein the originating network and the foreign network are considered the first and the second network, respectively. The E.164 represents the international phone numbering system, or the E.164 identity, which is considered as a first type of address.

*checking requirements of message or set of messages or session from the message or message set or session set up request* (checking if the E.164 number is a valid IMS identity, see page 1, lines 34-35), and

*deciding based on the result of the requirements checking step, on the routing of the message or message set or session setup request* (if the E.164 is a valid IMS, the message would be routing to an own MGCF, see page 2, lines 27-35),

*wherein the requirements include at least one of media requirements or QOS requirements of the message, set of messages, or requested session* (the step of checking if the

E.164 being a valid IMS includes obtaining the valid IMS identity in the trusted networks or in the target network, see page 2, lines 21-28).

Regarding claim 45, the E.164 represents the international phone numbering system, or the E.164 identity, which is considered as a first type of address. According to the APA, the message could be converted to a valid IMS routing address, see page 2. In other words, the E.164 identity is now transformed to routable IMS identity, which is considered as a second type of address.

Regarding claim 48, in the APA a S-CSCF performs the requirement checking step, see page 2, lines 3-12.

Regarding claim 56, the APA discloses the first database is an ENUM DNS database and comprises IMS E. 164 identities of the subscribers who have the first network as a home network, see page 1.

Regarding claim 57, the APA discloses the first database contains E. 164 identities of trusted operators, see page 1(C3).

Regarding claim 58, the APA discloses the first type of address is an E. 164 identity and the second type of address is a routable IMS identity.

Regarding claim 60, this claim has similar limitations as claim 42. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 42. The second network inherently includes a media gateway element or MGCF. And the message will be routing from the first network to the media gateway to the BGCF.

Claim 61 has similar limitations as claim 42. Therefore, it is rejected under claim 42 for the same reasons set forth in the rejection of claim 42.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 43-44, 49-55, 59, 80-85, and 87-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over the APA, in view of fig. 17.3.2.1-1, page 531 of the 3GPP TS 24.228 V5.0.0. March 2002, pp.1-681, (IDS record), hereinafter referred to as the 3GPP.

Regarding claim 43, the APA discloses all claimed limitation, except a step of deriving the address of a contact point of the second network in the first network, wherein the message is forwarded to the second network using the contact point of the second network.

The 3GPP discloses signaling flows for the IP multimedia call control based on SIP and SDP, see figure 17.3.2.1-1, pages 531-556. The S-CSCF#1 is the contact point of the Home Network #1 or the second network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the APA with the 3GPP. The suggestion/motivation for doing so would have been to provide an efficient interface for service exchange between circuit-switched and packet-switched communications network.

Regarding claim 44, the deriving step could be done using a second database (S-CSCF#1) in the 3GPP.

Regarding claim 49, in the 3GPP the BGCF performs the requirement checking step.

Regarding claim 50, in the 3GPP the first or second network or another network involved in routing the message or session setup request, includes a Call State Control Function and a Breakout Gateway Control Function, the Call State Control Function and the Breakout Gateway Control Function being adapted to utilize at least partly different DNS databases for translating an identifier of an equipment indicated in the message or session setup request, into a routing information.

Regarding claim 51, in the 3GPP a Control Function could be configured, preferably a Dividing Gateway Control Function, to perform the requirement checking step and takes care of routing incoming traffic from IP multimedia networks.

Regarding claim 52, in the 3GPP the second network includes a breakout element, preferably a Breakout Gateway Control Function, and an interrogating element, preferably an

Interrogating" Call State Control Function, and an additional path is provided from the breakout element to the interrogating element for routing a message.

Regarding claim 53, in the 3GPP when an identifier of the second network includes a valid IMS identity, the message is routed from the breakout element to the interrogating element, otherwise the message is routed to a media gateway element, preferably a Media Gateway Control Function.

Regarding claim 54, in the 3GPP, when the message is routed from the breakout element to the interrogating element, the breakout element is adapted to drop itself out so that the routing is a normal IMS session.

Regarding claim 55, in the 3GPP the contact point is an I-CSCF, BGCF or DGCF.

Regarding claim 59, in the 3GPP the routable IMS identity is a SIP URI.

Regarding claim 80, this claim has similar limitations as claims 61 and 43. Therefore, it is rejected under the APA-3GPP for the same reasons set forth in the rejection of claims 61 and 43.

Regarding claim 81, in the 3GPP the Control Function is a Serving Call State Control Function, S-CSCF.

Regarding claim 82, in the 3GPP the Control Function is a Breakout Gateway Control Function, BGCF.

Regarding claim 83, this claim has similar limitations as claim 80. Therefore, it is rejected under the APA-3GPP for the same reasons set forth in the rejection of claim 80.

Regarding claim 84, this claim has similar limitations as claims 42 and 43. Therefore, it is rejected under the APA-3GPP for the same reasons set forth in the rejection of claims 42 and 43.

Regarding claim 85, in the APA the step of checking if the E.164 being a valid IMS includes obtaining the valid IMS identity in the trusted networks or in the target network, see page 2, lines 21-28.

Regarding claim 87, in the APA a S-CSCF performs the requirement checking step, see page 2, lines 3-12.

Regarding claim 88, in the 3GPP the BGCF performs the requirement checking step.

*Allowable subject matter*

6. Claim 86 is objected to as being independent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 272-2988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

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/DUC C HO/

Primary Examiner, Art Unit 2419

08-22-09